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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,117	09/29/2001	Robert D. Dickinson III	TUMB-102 CON2	9177

26137 7590 06/01/2004

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
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NEW YORK, NY 10036

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 06/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application No.

09/967,117

Applicant(s)

DICKINSON ET AL.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8.9.14.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-10-2003 has been entered.

2. Claims 1-26 were pending in this case as of the mailing of the previous Office Action. New claims 27 and 28 have been added by the latest amendment. Claims 1-28 have been examined.

Claim Rejections - 35 USC § 112

3. Claims 7, 16, 17, 18, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims each contain the limitation of "...an e-mail firewall associated with an organization..." It is unclear what the Applicant intends the term "Organization" to encompass or how the term limits the claim in any way since any firewall may be associated with an organization simply by virtue of the necessity of use of an ISP for Internet connectivity.

Claims 8-28 are dependent on claims 7, 18, and 25 and are therefore rejected on the same basis as those claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Landfield, US Patent 5,632,011, Bruce Schneier: Applied cryptography 2nd Edition, Oct. 1995, John Wiley & Sons Pub., and Aziz, US Patent 5,416,842.

As per claim 1, Landfield teaches a method for transmitting a message between a sender user associated with a first email firewall and a recipient user associated with a second e-mail firewall, the method comprising: intercepting a plurality of packets associated with a message from the sender user intended for the recipient user (abstract); said data packets generated by a process outside of said first e-mail firewall (fig. 1); assembling said data packets to an application level message (col. 4 lines 18-21) searching an encryption directory for an entry associated with the second e-mail firewall associated with the recipient user (col. 4 lines 25-45); retrieving an encryption key associated with the second e-mail firewall, the second firewall associated with a plurality of recipient users; encoding the assembled message and allowing the message to proceed through the firewall (fig 2a, b, c) to the recipient user. Landfield does not explicitly teach encrypting with an encryption key associated with the second e-mail firewall to provide an encrypted message, however Aziz does teach this step (Abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Landfield. It would be desirable to do so as this would increase the security of the communications system.

As per claim 2, Landfield does not explicitly teach encoding the message is by employing an encryption key that is stored locally by the first e-mail firewall however such is taught implicitly by fig. 2c items 52 and 54 where a message is received in encrypted form.

As per claims 3 -5, Landfield does not teach encoding the message is by employing an encryption key that is retrieved from an external server over a secure data link that employs a locally stored encryption key associated with the external server. However Schneier teaches such, pages 185-187: "Public Key Management" Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Schneier into the system of Landfield. It would have been desirable to do so as this would decrease storage overhead at the firewall.

As per claim 6, Landfield teaches a method for receiving a message from a sender user associated with a first e-mail firewall by a recipient user associated with a second e-mail firewall, and ultimately allowing the message to proceed through the firewall to the recipient user, but does not teach the first e-mail firewall encoding the message by using an encryption key of the second e-mail firewall, comprising: intercepting the message; by the second e-mail firewall; decoding the message with a private key of the second e-mail firewall. Schneier does teach these steps at pages 31-33 and 185-187. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Schneier into the system of Landfield. It would have been desirable to do so as this would decrease storage overhead at the firewall.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

5-28-2004

Paul Callahan